

## **REMARKS/ARGUMENTS**

Applicants acknowledge receipt of the Final Office Action dated June 23, 2008, and in response submit the foregoing amendments and the following remarks, together with the accompanying Request for Continued Examination (RCE).

### **I. STATUS OF CLAIMS**

Claims 1-54 are canceled without prejudice.

New claims 55-82 are introduced.

Claims 55-82 are currently pending.

### **II. REJECTIONS UNDER 35 U.S.C. § 112, 2<sup>ND</sup> PARAGRAPH**

In the Office Action of June rejected claims 49-54 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as being allegedly indefinite for failing to recite values for superscripts "m" and "n" with respect to structure (V). This objection is now moot with respect claims 49-54. New claim 55 encompasses the subject matter of now canceled claim 54, and recites that "m" and "n" are independently integers from 0 to 4. Support for this limitation is implicit in paragraph [0036], [0038] and [0039], where it can be readily seen that structural formula (V) is a subset of formula (IV), which provides that "m" and "n" are independently integers from 0 to 4. In paragraph [0036], "m" and "n" are each 1, and the definition of "G" encompasses  $\text{---}(\text{CH}_2)_p\text{---}$  of formula (V).

### **III. REJECTIONS UNDER 35 U.S.C. § 103(a)**

In the Office Action of June 23, 2008, claims 49-53 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Cousin et al (U.S. Pat. No. 4,554,181, hereinafter "Cousin"), in view of Nigam (U.S. Pub. No. 2003/0219539, hereinafter "Nigam '539") and Nigam (U.S. Pat. No. 6,197,880, hereinafter "Nigam '880"). It is said that Cousin teaches an ink-jet recording sheet surface coated with a guanidine-formaldehyde polymer and polyvalent metal salt. While acknowledging that Cousin does not disclose cationic guanidine polymers having monomer units described by structural formulae III to VI and VIII, the Office Action takes the position that Nigam '539 and Nigam '880 disclose those formulae. Without conceding this point, and in order to

advance prosecution of this application, Applicants have chosen to delete claims 49-53, and are currently adding new claims 69-79, which are each drawn to a print medium in which the substrate contains a guanidine polymer described by formula VII, which is indicated in the Office Action as being free of the cited references. It should also be noted that in the earlier Office Action of January 8, 2008, it was indicated that the composition of matter claims 29-42 (now canceled), limited to formula VII, were allowable over the prior art. Accordingly, new claims 69-79 are believed to be likewise allowable over the cited references.

#### **IV. ALLOWABLE SUBJECT MATTER**

In the Office Action of June 23, 2008, it is said that claim 54 would be allowable if rewritten or amended to overcome the 112, 2<sup>nd</sup> paragraph rejection as set forth in the Office Action. Claim 54 is now canceled in favor of new claim 55, which, like previous claim 54, is drawn to a method of making a print medium that includes combining the guanidine polymers and metallic salt with the fibrous material before forming the substrate. As noted in the Office Action of June 23, 2008 (on page 7), Cousin expressly teaches that the polyvalent metal salts and guanidine polymers cannot be added in the wet end of the papermaking process or their effectiveness is compromised. Accordingly, new claims 54-67 are all free of the cited references for at least the same reason as previous claim 54 (now canceled).

The Office Action of June 23, 2008 also notes (on page 7) that none of the prior art teaches or suggests both internal sizing and external coating using the guanidine polymer. Accordingly, new claim 68, which depends from new claim 55, includes the further limitation of "applying a surface sizing composition containing said cationic guanidine polymer compound or salt thereof and a metallic salt onto said substrate."

New claims 80-82 are drawn to print media in which certain formula I or formula II guanidine polymers and sodium chloride are disposed within and around the fibers in the substrate. These claims are added to reintroduce subject matter of canceled claims 8-10. Notably, claims 8-10 were indicated in the previous Office Action of January 8, 2008 as being substantially allowable. That

Office Action stated (on page 7) that the claimed polymers have no hydrochloride and would not be expected to function similarly to the guanidine hydrochloride as binders in the cited references. It was further stated in that Office Action that the prior art discloses a polyvalent metallic salt with the claimed polymers, whereas sodium chloride is a monovalent salt and would not be expected to function similarly to a polyvalent salt. Accordingly, new claims 80-82 are believed to be in condition for allowance.

**V. ADDITIONAL AMENDMENTS**

In addition to the amendments discussed above, paragraphs [0022] and [0029] of the specification are currently amended to correct obvious typographical errors. New claim 64 is drawn to an embodiment wherein the guanidine polymer component contains a mixture of polymers of varying chain length, as described in the specification at paragraph [0048], for example.

**VI. CONCLUSION**

Applicants request entry of the foregoing amendments, reconsideration of the objections and rejections, and allowance of all pending claims.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including

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fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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